REMARKS

This Application has been carefully reviewed in light of the Office Action dated August 19, 2009 ("*Office Action*"). At the time of the *Office Action*, Claims 1-32 were pending and rejected. Applicants have amended Claims 1,14, and 28. Applicants submit that no new matter has been added by these amendments. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Section 101 Rejections

The Examiner rejects Claims 1-13 under 35 U.S.C. § 101 as not being (1) be tied to a particular machine or apparatus, or (2) transforming a particular article to a different state or thing. (*Office Action*, page 2). Although Applicants believe that the claims as originally submitted do in fact recite statutory subject matter, in order to advance prosecution of this Application, Applicants have amended independent Claim 1 to recite "using a computer operated by the merchant from whom the item was acquired or a specialized returns center associated with the merchant to process returns" to perform certain recited functions. Accordingly, Applicants submit that Claims 1-13 recite patentable subject matter.

For at least these reasons, Applicants respectfully request that the rejections of Claims 1-13 under 35 U.S.C. § 101 be withdrawn.

Section 103 Rejections

The Examiner rejects Claims 1-32 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0010689 issued to Tibbs et al. ("*Tibbs*") in view of U.S. Patent No. 6,015,167 issued to Savino et al. ("*Savino*").

Independent Claim 1 of the present Application, as amended, recites:

> A computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the steps of:
> accessing item data representing at least one detail about the item;
> accessing transaction data representing at least one detail about the transaction associated with the item;

accessing customer data representing at least one detail about a customer associated with the transaction;

accessing package data representing at least one detail about the package in which the item is expected to be shipped;

using a computer operated by the merchant from whom the item was acquired or a specialized returns center associated with the merchant to process returns to correlate the item data, transaction data, customer data, and package data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center;

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped, using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to generate a third-party machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represented by the third-party machine readable code includes the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction; and

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped from the customer to the returns center, using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label, such that the return shipping label contains the third-party machine readable code and complies with shipping label specifications of the choice of carrier, the third-party machine readable code in addition to a carrier-specified machine readable code also present on the shipping label.

Whether considered alone or in combination, *Tibbs* and *Savino* do not disclose, either expressly or inherently, each and every element of the claims.

For example, Applicants respectfully submit that the proposed *Tibbs-Savino* combination does not disclose, teach, or suggest "using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label, such that the return shipping label contains the third-party machine readable code and complies with shipping label specifications of the choice of carrier, the third-party machine readable code in addition to a carrier-specified machine readable code also present on the shipping label," as recited in Applicants' Claim 1.

In the *Office Action*, the Examiner relies upon *Tibbs* for disclosure of Applicants' operational steps of generating a bar-code and formatting the label." (*Office Action*, page 4). The Examiner acknowledges, however, that the machine readable code of *Tibbs* does not represent the shipping information such as item data, customer data transaction data, and package data and instead relies upon *Savino*. (*Office Action*, page 6). Applicants respectfully disagree with any finding that the combination of references disclose Applicants' recited claim elements.

To the extent that *Tibbs* discloses the generation of a barcode and shipping label, such label is a "typical return shipping label 200 and includes: a ship form address 215, ship to address 220, Maxicode 225, post office code 235, post office bar code 240, carrier tracking number 245, carrier bar code 250, and service identification 255." (*Tibbs*, paragraph 34). Thus, as acknowledged by the Examiner the shipping label of *Tibbs* is merely a standard carrier shipping label and does not include a "third-party machine readable code" other than a carrier code. For the actual generation of the shipping label, *Tibbs* further discloses that "the merchant server 1110 (see also FIG. 2) establishes a link with the ASP server 130 via the computer network 100 and transmits shipping information related to the customer return request." (*Tibbs*, paragraph 32). The ASP server or ASP application 130, which is associated with a carrier server, then validates the shipping information against the shipping rules of the carrier. (*Tibbs*, Figure 2; paragraph 33). The ASP application then "uses the shipping information from the merchant and the tracking information from the carrier to generate an electronic return shipping label." (*Tibbs*, paragraph 34). Thus, *Tibbs* makes clear that the generation of the label is by a party other than the merchant. However, *Tibbs* does not at all disclose, teach, or suggest a specialized returns center for performing returns processing. Accordingly, *Tibbs* "using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label, such that the return shipping label contains the third-party machine readable code and complies with shipping label specifications of the choice of carrier, the third-party machine readable code in addition to a carrier-specified machine readable code also present on the shipping label," as recited in Applicants' Claim 1.

Savino does not cure the deficiencies of *Tibbs*. While *Savino* describes "a shipping label" that includes "a single bar code" that is "linked with purchase and shipping information associated with a purchase order" (*Savino*, Column 2, lines 7-10), the shipping

label is not a carrier label and is not in compliance with shipping label specifications of a selected carrier. Rather, the label merely includes the bar code identifying a packing slip number and printed matter that relates to the customer purchase order no., the number of boxes, the quantity, and the customer part number. (*Savino*, Figure 3). With regard to the "shipping label," *Savino* states:

> FIG. 3 illustrates a shipping label 100 generated by the system 10 in accordance with the present invention. The shipping label includes a single-block bar code 102 which when scanned accesses the scanning system to a plurality of predetermined relevant purchase and shipping information associated with a purchase order which is stored in the supplier database 14 or digital processor 12. A "trigger number" 104 provides an alternative means for accessing the purchase and shipping information provided by the bar code 102. The shipping label 100 may also list some of the purchase and shipping information such as, for example, a customer purchase order number 106, a box quantity number 108, a part quantity number 110 and a customer part number 112.

(*Savino*, column 3, lines 48-61). Thus, though the label is termed a "shipping label" it is not a carrier label and has none of the usual features of a shipping label. Certainly, it does not comply with shipping label specifications of the choice of carrier, the third-party machine readable code in addition to a carrier-specified machine readable code also present on the shipping label.

Accordingly, no reference discloses, teaches, or suggests "using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label, such that the return shipping label contains the third-party machine readable code and complies with shipping label specifications of the choice of carrier, the third-party machine readable code in addition to a carrier-specified machine readable code also present on the shipping label," as recited in Claim 1. Additionally, The combination of references do not explain how a merchant would create such a label that includes both a third-party machine readable code and a carrier bar code. Likewise, the combination of references do not explain how a computer operated by the merchant or a specialized return center could produce such a label that complies with carrier issued shipping label specifications. In fact, *Tibbs* indicates that such a label should be produced by the carrier itself or an associated application.

Furthermore, the Examiner acknowledges that *Savino* relates specifically to a "single bar code shipping label." (*Office Action*, page 6). Throughout, *Savino* praises a label that includes a **single** bar code. According to *Savino*, "if for example, nine bar codes are provided with each packing slip, it will typically take about one minute to scan-in each nine-block label." (*Savino*, Column 1, lines 43-45). As another example, *Savino* explains that "several bar codes increases the likelihood that one or more of the bar codes provides incorrect information." (*Savino*, Column 1, lines 48-50). Thus, *Savino* actually teaches away from a shipping label that includes more than one bar code. Accordingly, *Savino* teaches away from a "return shipping label contains the third-party machine readable code and complies with shipping label specifications of the choice of carrier, the third-party machine readable code in addition to a carrier-specified machine readable code also present on the shipping label," as recited in Claim 1.

Finally, Applicants respectfully note that *Savino* does not relate to a returns process. Rather, the system of *Savino* is designed to prevent the need for returns. Accordingly, though the merchant of *Savino* prepares the shipping label, the shipping label is generated for inclusion in the packages shipped from the merchant to the customer. (Column 4, lines 14-20). In fact, a stated object of *Savino* is to prevent "premature shipments or 'ship aheads' [that] lead to prematurely reduced inventories and often result in wasted time and expense to both customer and supplier in returning the unauthorized shipment." (*Savino*, Column 1, lines 32-35). Thus, the purpose of the shipping label of *Savino* is that of a packing slip used in the fulfillment of orders by a merchant to a customer and not for use in the processing of returns from the customer to the merchant. Accordingly, one of ordinary skill in the art at the time of Applicants' invention would not have been motivated to combine the standard carrier label of *Tibbs* for use in shipping return products with the product specific bar code of *Savino* designed to prevent returns to result in "using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label, such that the return shipping label contains the third-party machine readable code and complies with shipping label specifications of the choice of carrier, the third-party machine readable code in addition to a carrier-specified machine readable code also present on the shipping label," as recited in Claim 1.

As another example of the deficiencies of the proposed *Tibbs-Savino* combination, Applicants respectfully submit that the cited references do not disclose, teach, or suggest "a

set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center," as recited in Claim 1. In the *Office Action*, the Examiner states "[a]s for the "business rules" feature, it is inherent that when a return request is made by a customer , business rules would be applied in order to determine what shipping information should be provided to the customer." (*Office Action*, pages 5-6). Applicants' respectfully disagree, however, with the Examiner's reliance upon inherency for disclosure of Applicants' "set of stored business rules to determine coding to be printed on a return shipping label, wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center," as recited in Claim 1.

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." M.P.E.P. § 2112; *See In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In this instance, the Examiner has not shown that it necessarily flows from the teachings of *Tibbs* that a set of business rules is used to determine coding to be printed on a return shipping label. Certainly, the Examiner has not shown that it necessarily flows from the teachings of *Tibbs* that a set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center. There is no disclosure in *Tibbs* at all relating to there being more than one choice of carrier or of determining such a choice of carrier. There is no disclosure that package disposition is a factor in generating the machine

readable coding. Accordingly, Applicants respectfully submit that Applicants' recited claim elements do not necessarily flow from and, thus, are not inherently taught by *Tibbs*.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 1, together with Claims 2-13[1] that depend on Claim 1. For analogous reasons, Applicants request reconsideration and allowance of independent Claims 14 and 28, together with Claims 15-27 and 29-32[2] that depend on Claims 14 and 28, respectively.

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[1] Applicants do not acquiesce to the Examiner's finding that Claims 2-13 and 19-27 recite information/data that is non-functional descriptive material. However, since Applicants have shown the independent Claims to be allowable, Applicants have chosen not to argue the dependent claims. Applicants reserve the right to argue these claims in the future should it become appropriate.

[2] Applicants do not acquiesce to the Examiner's finding that the business rules of Claims 29-32 are inherently disclosed in *Tibbs*. Rather, Applicants expressly dispute this finding and submit that for reasons similar to those described with regard to Claim 1, the claim elements recited in Claims 29-32 are not inherent from the disclosure of *Tibbs*.
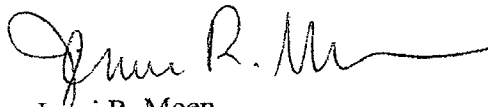
CONCLUSION

Applicants have made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 415-4820.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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